

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
Clifton Lind et al. )  
Serial No.: 10/643,189 ) Group Art Unit: 3714  
Filed: August 18, 2003 ) Examiner:  
FOR: DYNAMICALLY CONFIGURABLE ) Binh An Duc Nguyen  
GAMING SYSTEM ) Confirmation No.: 3668

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
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**APPELLANTS' REPLY BRIEF**

This Reply Brief is filed pursuant to 37 C.F.R. §41.41 in response to the Examiner's Answer (the "Answer") mailed July 25, 2007, regarding the above-identified application. Appellants submit this Reply Brief within the two-month period following the mailing of the Answer.

## I. STATUS OF THE CLAIMS

1. Claims 32, 33, 39, 40, and 42 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0166648 A1, Pub. date Jul. 15, 2004, at ¶¶ 11-13.

“Rothschild reference”)

2. Claims 25-31, 34-38, and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rothschild in view of U.S. Patent No. 5,923,252 to Sizer et al. ("Sizer" or the "Sizer patent").

The Appellants maintain all of the arguments set out in the Appellants' Appeal Brief filed March 27, 2007 in the present case, and present the following additional arguments in view of the Answer.

## II. ARGUMENT

A. THE ANSWER FAILS TO SHOW THAT THE ROTHSCHILD REFERENCE DISCLOSES EACH ELEMENT REQUIRED BY CLAIMS 32, 33, 39, 40, AND 42, AND THUS FAILS TO SHOW THAT THESE CLAIMS ARE ANTICIPATED BY THE ROTHSCHILD REFERENCE.

### **Claim 32**

Element (b) of claim 32 requires:

a player data collection arrangement for detecting that a person has been assigned to the hotel room in which the gaming machine is located and for storing player preference information for the person assigned to the hotel room.

This element unambiguously requires a device that functions to detect that a person has been assigned to a hotel room in which a gaming machine is located. The Answer at page 8 refers to paragraphs 31-33 of Rothschild as disclosing the element required at element (b) of claim 32. It

1 is clear from a review of paragraphs 31-33 of Rothschild (reproduced in the Answer at pages 8-9)  
2 that they simply do not disclose any device that functions to detect that a person has been  
3 assigned to a hotel room in which a gaming machine is located. The only reference to a hotel in  
4 the cited paragraphs is a reference to a “casino/hotel database 40c.” The mere reference to a  
5 “casino/hotel database” in paragraph 32 of Rothschild and the reference to a “computing device  
6 14” that may be used in a hotel room (Rothschild at paragraph 22) is a far cry from disclosing or  
7 even suggesting a device capable of detecting that a person has been assigned to a hotel room in  
8 which a gaming machine is located. The portions of the Rothschild reference that the Answer  
9 cites for disclosing the requirements of element (b) of claim 32 simply do not disclose those  
10 requirements.

11       The references to Rothschild listed in the Answer as showing the requirements of  
12 elements (c) and (d) are also deficient. The Answer cites paragraphs 22, 24, and 30 of  
13 Rothschild (reproduced at pages 9 through 11 of the Answer) as disclosing the limitation set out  
14 at element (c) of claim 32. However, nothing in the cited paragraphs discloses or suggests “a  
15 system configuration arrangement for producing a system configuration command based on the  
16 player preference information for the person assigned to the hotel room” as required at element  
17 (c) of claim 32. The Answer cites paragraph 31 of the Rothschild reference (reproduced at page  
18 11 of the Answer) as disclosing the limitation set out at element (d) of claim 32. However,  
19 nothing in paragraph 31 of Rothschild discloses or suggests any element “for responding to the  
20 system configuration command by communicating presentation switching instructions to the  
21 gaming machine, the presentation switching instructions causing the gaming machine to produce  
22 a game presentation specified by the presentation switching instructions.” In particular, the fact

1       that a casino's player tracking system stores game preference variables as disclosed in paragraph  
2       31 of Rothschild does not lead to the conclusion that this information is used to set up a given  
3       gaming machine, and certainly does not lead to the conclusion that the information is used to set  
4       up a gaming machine in a hotel room for a player assigned to that hotel room.

5           Because the Rothschild reference does not explicitly or inherently disclose the structure  
6       required at any of elements (b), (c), and (d) of claim 32, the Rothschild reference cannot  
7       anticipate claim 32. The Appellants therefore respectfully maintain that the anticipation rejection  
8       of claim 32 in view of Rothschild is in error and should be reversed along with the anticipation  
9       rejection of claim 33 which depends from claim 32.

10          The Appellants note the analysis set out in the Answer at lines 1-6 of page 12. Even  
11       taking all of the statements regarding the Rothschild reference in this analysis at face value,  
12       nothing in the analysis compels the stated conclusion that claim 32 is anticipated by the  
13       Rothschild reference. In fact, the statements regarding Rothschild set out in the Answer at lines  
14       1-6 of page 12 are totally divorced from the requirements of claim 32. That is, the analysis does  
15       not compare the elements purported to be disclosed in Rothschild with the Appellants' claim  
16       language under consideration. Thus the analysis set out in the Answer at lines 1-6 of page 12 is  
17       clearly in error.

18          Furthermore, the Appellants believe that the statements at the top of page 12 of the  
19       Answer cannot be taken at face value. In particular, the Appellants find no support in Rothschild  
20       for the proposition that "the gaming system of Rothschild allows the player to access the hotel  
21       using the tracking card...."

1       Claims 39 and 42

2           As discussed in the Appellants Appeal Brief at pages 12-14, claims 39 and 42 are,  
3       respectively, method and program product claims requiring limitations corresponding generally  
4       to those set out in apparatus form in claim 32. The Answer applies the same disclosure from the  
5       Rothschild reference against corresponding elements of claims 39 and 42 as it applies to claim  
6       32. Therefore the above comments regarding the analysis in the Answer as to claim 32 applies  
7       with equal force to claims 39 and 42. Perhaps most importantly, the mere references to a  
8       hotel/casino database 40c and computing devices 14 in Rothschild do not amount to a disclosure  
9       of detecting that a player has been assigned to a hotel room in which a gaming machine is located  
10      as required at element (a) of claim 39, nor does it amount to a disclosure of system configuration  
11      program code executable for retrieving game preference information on a player that has been  
12      assigned to a hotel room in which a gaming machine is located as required at element (a) of  
13      claim 42.

14           Because the Rothschild reference does not explicitly or inherently disclose all of the  
15      elements required in claims 39 and 42, the Rothschild reference cannot anticipate these claims.  
16      The Appellants therefore respectfully maintain that the anticipation rejection of claims 39 and 42  
17      in view of Rothschild is in error and should be reversed along with the anticipation rejection of  
18      claim 40 which depends from claim 39.

1       B.     THE ANSWER FAILS TO SHOW THAT THE PROPOSED COMBINATION OF THE  
2           ROTHSCHILD REFERENCE AND THE SIZER PATENT INCLUDES EACH  
3           ELEMENT SET OUT IN CLAIMS 25-31, 34-38, AND 41.

4       The Answer does not address the errors described in the Appellants' Appeal Brief from  
5       page 15, line 13 to page 16, line 2, and from page 16, line 27 to page 17, line 4. Specifically, the  
6       Answer does not address the Appellants' position that even combining the marketing message  
7       device of Sizer with the gaming system of the Rothschild reference would still not meet the  
8       limitations in independent claims 25 and 34 of switching a game presentation at a gaming  
9       machine prior to an arrival of the approaching player at the gaming machine. If one were to  
10      combine the marketing message device of Sizer with the gaming system disclosed in Rothschild,  
11      the resulting system could do no more than display a marketing message to a casino patron who  
12      took some action in a particular area to trigger the marketing message (See Sizer at col. 2, line 30  
13      to col. 3, line 16 regarding the "determination means" for determining if a marketing message  
14      should be delivered). Combining the system disclosed in Rothschild with the marketing message  
15      system in the Sizer patent would certainly not result in changing game presentations at a gaming  
16      machine. Furthermore, the proposed combination of the system shown in Rothschild and the  
17      system shown in the Sizer patent would not suggest changing any display at a gaming machine in  
18      any way, including changing a display to show a marketing message. That is, there is no reason  
19      apparent in the prior art to provide the Sizer marketing message at a gaming machine rather than  
20      a separate device.

21       Not only is there no reason apparent in the prior art to provide the Sizer marketing  
22      message at a gaming machine in the system disclosed in Rothschild, but also elements of the  
23      Sizer marketing message delivery system suggest that it would not be appropriate to use a

1 gaming machine in the Rothschild system to display the desired marketing message. This is  
2 because the Sizer system emphasizes that the patron must take some action which indicates that a  
3 marketing message should be delivered. In particular, Sizer discloses that a marketing message  
4 should be delivered only if a patron shows an interest in a particular product (See Sizer at col. 15,  
5 lines 15-35). If this is applied in the context of a gaming system, the marketing message could  
6 interfere with the patron's interest in a given game. For example, a casino patron may linger at an  
7 unoccupied gaming machine while they review the attract graphics and pay tables displayed at  
8 the gaming machine. Displaying a marketing message rather than the attract graphics and pay  
9 tables which already caught the patron's attention would appear to be counterproductive to  
10 enticing the patron to play the game.

11 Finally, the Appellants note that the Answer also includes errors regarding the  
12 interpretation of the Sizer patent. In particular, the Answer at lines 9-11 of page 15 cites Sizer at  
13 col. 7, line 33 to col. 8, line 49; col. 15, lines 16-35; and col. 16, lines 14-32 for the proposition  
14 that product advertising messages are coordinated upon an arrival of the "player" along an aisle.  
15 First, Sizer does not disclose "players." Furthermore, the cited sections of Sizer do not disclose  
16 coordinating advertising messages upon an arrival of any customer at a given location.

17 For all of these reasons the Appellants respectfully submit that claims 25 and 34 are not  
18 obvious in view of the proposed combination of Rothschild and Sizer, and thus that the rejections  
19 of these claims and their respective dependent claims, claims 26-31 and claims 35-38, and 41, are  
20 in error and should be reversed.

## II. CONCLUSION

For all of these reasons and for the reasons set out in the Appellants' Brief, the Appellants submit that the rejection of claims 25-42 is in error, and submit that the claims are entitled to allowance. The Appellants therefore respectfully request that the Board reverse the decision of the Examiner rejecting these claims.

Respectfully submitted,

The Culbertson Group, P.C.

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